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Atty Dkt No. GP-302711 (GM-0330PUS)

REMARKS

Claims 1-28 are pending in this application. Claims 1-18 and 20-28 are rejected under 35 U.S.C. § 112, first paragraph. Claims 1, 2, 7-9, 18, 20, and 22-28 are rejected under 35 U.S.C. § 102(e) over United States Patent No. 6,467,768 (Schroeder et al. '768). Claim 16 is listed in Item 4 as being rejected under Section 102(e). However, the analysis presented by the Examiner under Item 6 makes it clear that claim 16 is actually rejected under Section 103(a) as being unpatentable over Schroeder et al. '768. Claim 19 is allowed.

Claim Rejections Under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 1-18 and claims 20-28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that:

The claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose how the inner member can be made in one-piece and the outer member can be made in one-piece. It is unclear how each of these members could be constructed according to the techniques disclosed by the applicant, as they are far more complex than any frame member made in one-piece according to the prior art. It is unclear how the members could be constructed without welding or joining in some manner smaller pieces to construct the inner or outer member.

(March 21, 2005 Office Action, Item 7, page 6, emphasis added)

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Three separate Declarations provided with the November 22, 2004 Reply were considered by the Examiner with respect to the Section 112, first paragraph rejections. The Examiner finds that the Declarations:

are insufficient to overcome the rejection of claims 1-18 and 20-28 based upon 35 U.S.C. 112, first paragraph as set forth in the last Office action because: The declarations only give expert opinion evidence given by experts in the employ of the assignee. As the experts have an interest in the outcome of the application, little weight is given to the declarations. No factual evidence is given by the declarations. The declarations amount to a legal conclusion that one of ordinary skill in the art would be able to make and use the invention from the Specification. Thus the declarations are given little weight. See MPEP 716.09 and 716.01(c).

Accordingly, the rejection is maintained since **no piece of prior art is of record disclosing a method that could be used to make such a structure as applicant describes or shows a structure similar to that of applicant.**

(emphasis added)

Applicants respectfully disagree with the Examiner's rejections under Section 112, first paragraph. The Specification clearly describes how to make the claimed body and frame assembly utilizing processes such as quick plastic forming, super plastic forming and sheet hydroforming (see paragraphs [0027] to [0032]). Section 2164.04 of the MPEP provides:

In order to make a [Section 112] rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)
(examiner must provide a reasonable explanation as to why the

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scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented **must be taken as being in compliance** with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. . . . As stated by the court [in *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971)], "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting a presumptively accurate disclosure. 439 F.2d at 224, 169 USPQ at 370. (emphasis added)

Applicants submit that the Examiner has not established a reasonable basis to question enablement. The Examiner has not found that the quick plastic forming, super plastic forming and sheet hydroforming techniques described in the Specification cannot be used to make a complex, one-piece component, but that they cannot be used to make a one-piece component of the size and complexity claimed. The Examiner's finding appears to be based only on his assessment of the prior art of record which he finds to be relating to smaller, less complex components.

The fact that the Examiner has found no prior art showing a structure similar to the one-piece inner member and one-piece outer member claimed and described by Applicants in the Specification only emphasizes the novelty and nonobviousness of Applicants' invention. Indeed, as attested to in item 6 of each of the

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Declarations, larger dies may be required to make the claimed one-piece inner member and one-piece outer member -- but this presents a cost issue, rather than an enablement issue. Thus, the Examiner's rejections amount to a finding that there is some unspecified size and shape at which a component becomes too large and complex to be made in one piece. It does not follow that the quick plastic forming and super plastic forming techniques described by Applicants are not enabling; i.e., that they are inherently limited to smaller, simpler components and cannot be employed, in conjunction with bending and other process steps described in the specification, to make Applicants' claimed one-piece inner member and one-piece outer member. In fact, the MPEP provides that "the mere fact that something has not previously been done clearly is not, in itself, a sufficient basis for rejecting all applications purporting to disclose how to do it." MPEP 2164.02 (discussing *Gould v. Quigg*, 822 F.2d 1074, 1078, 3 USPQ2d 1302, 1304 (Fed. Cir. 1987)).

The assignee of the present application, General Motors Corporation, has received numerous patents involving large and complex one-piece components formed utilizing quick plastic forming, super plastic forming, and/or hydroforming, including:

U.S. Patent No. 6,886,885 (one-piece inner member and one-piece outer member with rear and side panel portions)

U.S. Patent No. 6,846,038 (one piece inner member and one-piece outer member each defining a hood portion and two fender portions)

U.S. Patent No. 6,845,839 (one-piece vehicle floorpan)

U.S. Patent No. 6,843,336 (one-piece vehicle belly pan)

U.S. Patent No. 5,666,727 (one-piece passenger compartment)

Applicants further submit that the Examiner's determination of the Specification's failure to meet the enablement requirement of Section 112, first paragraph is simply a personal opinion of the Examiner. The MPEP provides that:

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The Examiner should never make the determination based on personal opinion. The determination should always be based upon the weight of all the evidence.

MPEP 2164.05

The Declarations do not "give only expert opinion evidence" with "no factual evidence," thereby amounting to a "legal conclusion" as stated by the Examiner. In Item 5 of each of the Declarations, the Declarant attests to his knowledge of a variety of complex shapes that may be made utilizing the forming processes described in the Specification. Additionally, possible explanations for why the Examiner has found no similar prior art are set forth in Item 6: i.e., (i) handling issues and (ii) die cost associated with larger components.

Thus, because (i) there is no reasonable basis for the Examiner to question enablement and (ii) the weight of the evidence supports enablement, Applicants respectfully request that the Examiner reconsider his rejections under Section 112, first paragraph.

Claim Rejections Under 35 U.S.C. § 102(e)

The Examiner has rejected claims 1, 2, 7-9, 18, 20 and 22-28 under 35 U.S.C. § 102(e) as being anticipated by Schroeder et al. '768. According to the Examiner, with respect to independent claim 1, Schroeder et al. '768 discloses:

a body and frame assembly for a vehicle comprising a one-piece inner member (26) mated with a one-piece outer member (16a), the inner member (16b) defining door openings at opposing sides of the vehicle and the outer member further defining the door openings at the opposing sides of the vehicle.

With respect to independent claim 20, the Examiner finds that Schroeder et al. '768 discloses:

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a method of assembling a vehicle comprising forming a one-piece inner member, forming a one-piece outer member matable with the inner member, and mounting the inner and outer members to each other such that the inner member defines door openings at opposing sides of the vehicle and the outer member further defines the door openings at the opposing side of the vehicle (see figures 1 and 2).

For a rejection to be proper as an anticipation under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the 102 reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131.

Claim 1 has been amended to specify that "[the] inner member and [the] outer member are metal." Additionally, claim 20 has been amended to specify that forming the inner member and forming the outer member "are by a method selected from the group consisting of quick plastic forming, super plastic forming and hydroforming."

The Examiner named one-piece outer member 16a of Schroeder et al. '768 is plastic and is formed by integrating a reinforcing component 13 into the injection molded plastic vehicle body panel 11. (Col. 2, lines 52-53, Col. 3, lines 3-5 (reference numbers 11 and 13 not shown)). The reinforcing component 13 is comprised of a structural fiber material 30 and an opaque film 32. Col. 2, lines 46-52. The one-piece inner member 16b is also plastic, and is presumably also injection molded. Therefore, the limitation of claim 1, "wherein said inner member and said outer member are metal" are not met by Schroeder et al. Additionally, because Schroeder et al. '768 teaches only that a thermoplastic forming process may be used to make the inner and outer members 16a and 16b, Schroeder et al. '768 does not enable the making of metal components. Similarly, the limitations of claim 20, specifically, forming the one-piece inner and one-piece outer members "by a method selected from the group consisting of quick plastic forming, super plastic forming and hydroforming" are not met. Thus, because claims 1

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and 20 are not anticipated by Schroeder et al., the rejections of claims 1 and 20 and of claims 2, 7-9, 18 and 22-28 which respectively depend therefrom are believed to be overcome.

Claim Rejections Under 35 U.S.C. § 103(a)

Claim 16 is rejected by the Examiner under Section 103(a) as being unpatentable over Schroeder et al. '768 because "Schroeder et al. disclose all of the limitations of the claim, as applied above, except for the inner member and the outer member being joined by at least partially bonding." The Examiner then finds that it would have been obvious to modify the method of Schroeder et al. '768 to join the inner member and the outer member at least partially by bonding.

A *prima facie* case of obviousness requires that the prior art references teach or suggest all claim limitations of the examined claim. (MPEP 2143.03) Because Schroeder et al. '768 does not teach all of the elements and limitations of amended claim 1, from which claim 16 depends, the rejection of claim 16 under Section 103(a) is believed to be overcome by the amendment to claim 1.

Conclusion

In light of the above remarks, the amendments and the affidavits, it is believed that all of claims 1-18 and 20-28 are in condition for allowance along with allowed claim 19, which action is respectfully requested.

Respectfully submitted,

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